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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,325	04/05/2001	Ian Karl Jones	713-488	4159
22429	7590	03/22/2004	EXAMINER	
LOWE HAUPTMAN GILMAN AND BERNER, LLP 1700 DIAGONAL ROAD SUITE 300 /310 ALEXANDRIA, VA 22314			FERGUSON, LAWRENCE D	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 03/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/826,325

Applicant(s)

JONES, IAN KARL

Examiner

Lawrence D Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5-7, 9, 10, 12-14, 16-26 and 29-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-7, 22-24, 29-36, 40 and 44 is/are rejected.
- 7) ☒ Claim(s) 9, 10, 12-14, 16-21, 25, 26, 38, 39 and 41-43 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Amendment*

1. This action is in response to the amendment mailed December 12, 2003. Claims 10 and 17-18 were amended and claims 41-44 were added rendering claims 5-7, 9-10, 12-14, 16-26 and 29-44 pending.

### *Claim Rejections – 35 USC § 103(a)*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 5-7 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts Jr., U.S. Pat. No. 3,903,342.
4. Roberts Jr. shows a unitary or single ply sheet material (column 5, lines 22-25) where the sheet is used for packaging (column 12, lines 55-62). Roberts Jr. shows the sheet has a pattern (column 2, lines 41-45) and embossed protuberances (column 4, lines 45-60). Roberts Jr. shows a single ply sheet comprising continuous network regions with repeating patterns which are arranged in a manner wherein all lines projected onto the surface of the paper cut through the shaped protuberances and gaps in-between (Figure 5). Roberts Jr. shows the paper has a front surface, a rear surface, and a middle level comprising connecting webs of paper fibers which connect the

shaped protuberances (Figures 5-6 and abstract). Roberts Jr. shows that the connecting webs extend in lateral and perpendicular directions to the shaped protuberances and form a tessellated pattern (Figure 5). Roberts Jr. does not show that the packaging sheet has a compression strength as in instant claims 22-23. The compression strength is based on the type of packaging material used. Since the single ply packaging sheet material of Roberts Jr. is made of the same components as Applicant's, the compression strength would be expected to be the same, absent any evidence to the contrary. Roberts Jr. does not explicitly teach the thickness as in claim 24. Such thickness is a property which can be easily determined by one of ordinary skill in the art. With regard to the limitation of thickness, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. thickness) fails to render claims patentable in the absence of unexpected results. The aforementioned limitation is optimizable as it controls the resilience of the protrusioned surface so that the area available for contact has an increased level of cushioning and nesting. As such, the thickness is optimizable. It would have been obvious to one of ordinary skill in the art to make the packaging sheet with the limitations of the thickness since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 USPQ 215 (CCPA 1980).

***Claim Rejections – 35 USC § 103(a)***

5. Claims 29-36, 40 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rudy, U.S. Pat. No. 4,287,250.

6. Rudy shows a thermoplastic packaging sheet comprising repeated patterns (tessellations) of rounded shaped protuberances and gaps which are positioned such that any straight lines projected onto the surface of the paper cut through the shaped protuberances and gaps in-between (Figure 1). The reference shows the sheets are laminated and contain air (column 1, lines 15-24). Rudy shows that the repeating patterns are inverses of each other on the front and rear surfaces and that the contact surface areas of both surfaces are equal (Figures 2 and 3). Rudy shows that the sheet comprises a middle level comprising connecting webs (13) adjacent to the shaped protuberances and that the connecting webs (13) extend laterally and perpendicularly to the shaped protuberances (Figures 1, 3, and 4-5). Rudy shows that the distance between the front and rear surfaces is less than or equal to about 5 times the thickness of the sheet (Figures 2-3 and 5). Rudy does not show that the thermoplastic packaging sheet has a compression strength as in instant claim 35. The compression strength is based on the type of packaging material used. Since the packaging sheet material of Rudy is made of the same components as Applicant's, the compression strength would be expected to be the same, absent any evidence to the contrary. Rudy does not explicitly teach the thickness as in claim 36. Such thickness is a property which can be

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easily determined by one of ordinary skill in the art. With regard to the limitation of thickness, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. thickness) fails to render claims patentable in the absence of unexpected results. The aforementioned limitation is optimizable as it controls the resilience of the protrusioned surface so that the area available for contact has an increased level of cushioning and nesting. As such, the thickness is optimizable. It would have been obvious to one of ordinary skill in the art to make the packaging sheet with the limitations of the thickness since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 USPQ 215 (CCPA 1980).

7. Claims 9-10, 12-14, 16-21, 25-26, 38-39 and 41-43 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

8. Rejection of claims 5-7, 9, 21-26 made under 35 USC 112, first paragraph have been withdrawn due Applicants arguments pertaining to the disclosure of a single material layer as depicted in instant Figure 5.

Rejection made under 35 U.S.C. 103(a) as being unpatentable over Roberts Jr., U.S. Pat. No. 3,903,342 has been considered but is unpersuasive. Applicant argues Roberts does not disclose that the shaped protuberances being positioned in such a way that every straight line projected onto said sheets cuts through at least one of the shaped protuberances. Examiner maintains that cutting a straight line through (75) of Figure 5 does not cut through any of the protuberances of Roberts. It appears Applicant considers the gap (79) a protuberance, where both (75) and (79) make up the shaped protuberance of Roberts. Therefore, by projecting a straight line through (75) of figure 5, the protuberance is cut through. Applicant argues Roberts fails to disclose the claimed compression strength. The compression strength is based on the type of packaging material used. Since the single ply packaging sheet material of Roberts Jr. is made of the same components as Applicant's, the compression strength would be expected to be the same, absent any evidence to the contrary. Applicant argues if the Roberts product were modified to include the claimed compression strength, the product would be too hard and would not be satisfactory for the intended purpose of being used for towels and wipers. Intended use is given little patentable weight in a product claim.

Rejection made under 35 U.S.C. 103(a) as being unpatentable over Rudy, U.S. Pat. No. 4,287,250 in view of McGuire et al, U.S. Pat. No. 6,254,965 over claims 10, 12-14, 16, 19-20 and 38 are withdrawn due to applicants amendments and comprising more than a single material layer. Although McGuire is withdrawn due to disclosing only partially filled foam insulation, Rudy is maintained over instant claims 29-36, 39-40 and 44. Applicant argues claim 29 is not disclosed by Rudy because it does not suggest

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connecting webs. Examiner respectfully disagrees because Rudy discloses the connecting web (13 and 13a) in Figures 1-5.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the



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examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson  
Examiner  
Art Unit 1774

CYNTHIA M. KELLY  
SUPERVISOR  
ART EXAMINER  
FEB 17

